

REMARKS

This Amendment and Response is fully responsive to the Final Office Action mailed January 29, 2009 ("Office Action"). By these amendments, Claims 1-3, 8, 13, 15-18, 23-24, 28, 30-32, 35-44 have been amended; Claims 12 and 26 have been cancelled; and no claims have been added. After entry of these amendments, Claims 1-4, 8-9, 11, 13, 15-19, 23-24, 26, 28 and 30-44 remain pending. Support for the new claims can be found in the specification at least at paragraphs [0208] – [0232] and the corresponding figures discussed therein. Applicants respectfully submit that no new matter has been added by the foregoing amendments. In view of these amendments and remarks, Applicants respectfully assert that the rejections are now made moot and reconsideration and allowance of the application is respectfully requested.

Summary of Interview

Initially, Applicants thank Examiner Kim for graciously granting the telephonic interview on April 28, 2009 with Mr. Brian Decker, and for Examiner Kim's time and attention during the Interview. During the Interview, the present Application was discussed in light of the pending rejections under 35 U.S.C. §§ 101, 112, and 103. With respect to the rejection of Claim 44 under § 101, Mr. Decker identified portions of the Specification providing structure for performing the functions recited for each of the features and agreed to explicitly identify them in the remarks of the present Amendment and Response. With respect to the rejections under § 112, Examiner Kim kindly explained his basis for rejections for each of the rejected claims and requested Applicants clarify the features either through these remarks or amendment. With respect to the rejections under § 103, Mr. Decker and Examiner Kim discussed the scope of the Applicants claim as expressly recited in light of the cited prior art. No agreement was reached regarding the rejections under § 103.

Claim Rejections Under 35 U.S.C. § 101

In the Office Action, Claim 44 was rejected under 35 U.S.C. § 101 as allegedly being directed toward non-statutory subject matter, stating that the invention is disclosed in paragraph [0112] as computer software. First, contrary to that stated in the Office Action, software or

computer programs are not non-statutory per se. In *In re Bilski*, the Federal Circuit clearly states that there is no “broad exclusion over software or any other such category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court.” (545 F.3d 943, 960 n.23, 88 USPQ2d 1385 (Fed. Cir. Oct. 30, 2008)).

Notwithstanding, Claim 44 recites “A system” and multiple “means for” elements, which is clearly directed toward a system. It is undeniable that a system is statutory subject matter under § 101. In addition, as discussed during the Examiner’s Interview, the Specification as originally filed includes sufficient structure suitable for performing the functions as claimed in each of the claim limitations beginning with “means for,” as required under 35 U.S.C. § 112, paragraph six. An example of structure supporting the “means for storing . . .” is provided in Figure 3 as the data repository 310 and the respective databases 310A, 310B, 310C, each described in paragraphs [0138] and [0139]. An example of structure supporting the “means for receiving . . .” is also provided in Figure 3 as the communication interface 315, described in paragraph [0138], in communication with the network 206 (which is likewise described and illustrated with reference to Figure 2). Finally, an example of the structure supporting the “means for determining . . .” is provided by the processor(s) 303, memory(ies) 305, and data repository 310 of Figure 3. Algorithms and step-by-step processes describing example implementations of performing such a determination are illustrated in Figure 7 and the supporting description at paragraphs [0208]-[0232]. (*See Aristocrat Technologies Australia Pty Ltd. v. International Game Technology*, 543 F.3d 657, 86 USPQ2d 1235 (Fed. Cir. Sept. 22, 2008)).

Accordingly, Applicants respectfully submit that Claim 44 as recited is directed to statutory subject matter under 35 U.S.C. § 101, and request the rejection be withdrawn.

Moreover, Applicants have hereby amended independent method Claim 1 and certain claims depending therefrom to further clarify that the claim is “computer-implemented” and that the “steps are performed by the one or more payment servicing computers,” showing that the steps of the method are performed by a particular machine.

Claim Rejections under 35 U.S.C. § 112, first paragraph

In the Office Action, Claims 35, 36, and 41 were rejected under 35 U.S.C. § 112, first paragraph. By these amendments, Claims 35, 36, and 41 have been amended to remove the term “partial payment information” and to clarify that the what is received is “an identification of the payee.” Accordingly, Applicants respectfully submit that the Claims 35, 36, and 41 now have sufficient support in the specification as required under 35 U.S.C. § 112, first paragraph, and that the rejection be withdrawn.

Claim Rejections under 35 U.S.C. § 112, second paragraph

In the Office Action, Claims 1-4, 8-9, 11, 13, 15-19, 23-24, 26, 28, and 30-44 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly failing to define the invention. Applicants herein provide responses to the claims for which explicit reasons supporting the rejections were provided in the Office Action, as discussed during the Examiner’s Interview. Applicants respectfully submit that those claims for which reasons supporting the rejection were not given – Claims 2-3, 9, 13, 16-19, 24, 26, 28, 30, 32-41, and 44 – are definite and satisfy the requirements of § 112, second paragraph, and request that the rejections be withdrawn. If the Examiner disagrees, Applicants respectfully request that express reasoning supporting the rejection be provided.

With respect to Claims 8, 23, and 31, the Office Action stated that provided “at least” statements as allegedly being indefinite. Reciting the term “at least” does not per se render a claim indefinite, as provided by MPEP § 2173.05(h)(II)(citing *In re Gaubert*, 524 F.2d 1222, 187 USPQ 664 (CCPA 1975) finding the term “at least” to not be in violation of 35 U.S.C. § 112, second paragraph). As discussed during the Interview, the use of the term “at least” in each of Claims 8, 23, and 31 is intended to indicate that the features recited are not closed-ended and that other factors may be considered. For example, with reference to amended Claims 8 and 23, the payment lead time can be determined based on at least three factors – (a) stored information, (b) posting information, and *either* (c) deposit information *or* (d) settlement information. The use of the term “at least partially” indicates that other factors not explicitly recited may also be considered when making the payment lead time determination in addition to those expressly

recited. The use of “at least” before “the deposit information or the settlement information” indicates that both of those information types are not required to be considered (but could be). Similarly, the use of “at least partially” in amended Claim 31 indicates that the features are not closed-ended and that the average period can be adjusted based on factors in addition to those expressly recited. Accordingly, Applicants respectfully submit that Claims 8, 23, and 31, and any other claim including the terms “at least” or “at least partially” particularly point out and distinctly claim the invention as required by 35 U.S.C. § 112, second paragraph, and request the rejections be withdrawn.

With respect to Claim 24, the Office Action alleges that the “if” clauses are indefinite. First, Applicants submit that using an “if” statement does not per se render a claim indefinite. MPEP § 2173.05(h)(III) provides that alternatives or optional language can be acceptable if there is no ambiguity as to which alternatives or optional paths are covered. (citing *Ex parte Cordova*, 10 USPQ2d 1949 (BPAI 1989) and *Ex parte Wu*, 10 USPQ2d 2031 (BPAI 1989)). Amended Claim 24 clearly recites that the post-issue event information can be one of three options – (a) posting information, (b) deposit information, or (c) settlement information – and each of the three “if” clauses provides a step performed under a different one of the three information types. Thus, there are no ambiguities as to the scope of the claim and which “if” clause is applies to which information type. Moreover, there are no scenarios left unknown – each of the three information types is associated with a corresponding “if” clause. Accordingly, as discussed in the Interview, Applicants respectfully submit that Claim 24 does particularly point out and distinctly claim the invention as required by 35 U.S.C. § 112, second paragraph, and request the rejection be withdrawn. In addition, other dependent claims including “if” statements provide sufficient definiteness to the subject matter claimed in a similar manner, such as amended Claims 9, 31, and 39, satisfying the requirements of 35 U.S.C. § 112, second paragraph, and request the rejections be withdrawn.

With respect to Claim 43, Applicants have hereby amended Claim 43 to further clarify that “the payment option information,” which is originally recited in Claim 40, includes the “cost to the payor” for at least one of the two payment options, which are also originally recited in Claim 40. Applicants have also amended Claim 15 in a similar manner. Accordingly, in light of

theses amendments, Applicants respectfully submit that amended Claim 43 (and Claim 15) point out and distinctly claim the invention as required by 35 U.S.C. § 112, second paragraph, and request the rejections be withdrawn.

With respect to Claim 8, the Office Action states that “posting information” is included in Claim 8 but optional in Claim 4. As discussed in the interview, Applicants have hereby amended Claim 8 to include the statement “wherein the post-issue event information for each of the one or more payments includes posting information,” clarifying that method recited by Claim 8 expressly provides post-issue event information that does include posting information. Claim 23 has been similarly amended. Accordingly, in light of theses amendments, Applicants respectfully submit that amended Claim 8 (and Claim 23) point out and distinctly claim the invention as required by 35 U.S.C. § 112, second paragraph, and request the rejections be withdrawn.

With respect to Claim 31, the Office Action states that the step of “determining the adjustment period” is omitted. Applicants respectfully submit that the Claim as written is sufficiently clear and definite to one of ordinary skill in the art, and that there is no requirement to expressly recite features beyond the intended scope of the claim, even if those features may impact expressly recited features. Claim 31 clearly claims that a “predetermined depositing adjustment period” or a “predetermined settlement adjustment period” can be used to adjust the average period. Applicants do not intend the predeterminations of the settlement periods or the adjustment periods to be within the scope of Claim 31. Accordingly, Applicants respectfully submit that amended Claim 31 points out and distinctly claims the invention as required by 35 U.S.C. § 112, second paragraph, and request the rejection be withdrawn. If the Examiner disagrees, Applicants respectfully request the Office Action to provide controlling authority for upholding the rejection.

With respect to Claim 15, the Office Action identified that the preamble incorrectly recites “The method” Applicants have amended the claim so that Claim 15 now depends from Claim 32, a method claim, and thus request the rejection be withdrawn.

By these amendments, Claims 11 and 26 have been cancelled, rendering the rejections thereof under 35 U.S.C. § 112, second paragraph moot.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, Claims 1-4, 8-9, 11, 13, 15-19, 23-24, 26, 28, and 30-44 were rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over unpatentable over U.S. Patent Application No. 2003/0055783 to Cataline et al. ("*Cataline*"), in view of and U.S. Patent No. 6,658,393 to Basch et al. ("*Basch*") and U.S. Patent No. 6,505,249 to Rehkopf ("*Rehkopf*").

Applicants have hereby amended each of the independent claims to further clarify the distinctions of the claims over the cited art. Specifically, by example, Claim 1 has been amended to include the features of:

storing information identifying a payment issue time of each of one or more payments to a payee, wherein each of the one or more payments have a same form of payment;
receiving post-issue event information associated with each of the one or more payments;
determining a payment lead time, based upon the stored information and the post-issue event information, to complete a future payment to the payee issued on behalf of a payor, and associating the payment lead time with the payee

(Underlining supplied). As amended, Claim 1 clearly recites a process of determining a "payment lead time . . . to complete a future payment to [a given] payee" and associating that payment lead time with the given payee. The payment lead time that is determined is based upon one or more historical payments made using the same form of payment to the given payee, using a payment issue time and post-issue event information associated with each of the one or more historical payments to that payee. Accordingly, the process recited by Claim 1 provides for using past payment information associated with a given payee to identify and associate a payment lead time that may be used when performing future payment transactions to that payee. By using past payment information associated with the respective payee of interest, nuances associated with that payee that may effect payment lead times can be captured and accurately reflected for future transactions with that payee.

First, Applicants respectfully submit that the Office Action improperly dissects the claim elements such that they are being read to not give their full, intended meaning. In the Office Action, it is alleged that *Cataline* shows "determining a period of time to complete a future payment to the payment issued on behalf of a payor," but admitted that *Cataline* does not teach

or suggest the portion of “determining the period of time, based upon the stored information and the post-issue event information.” (Office Action, pg. 12, 14). In an effort to show an alleged teaching or suggestion of those portions of the element not provided by *Cataline*, the Office Action relies on *Rehkopf* for teaching “a period of time, based upon the stored information and the received post-issue event information.” (Office Action, pg. 14). The Office Action also provides similar reasoning in the Response to Arguments, wholly refusing to read the entire claim limitation as expressly recited. (See Office Action, pg. 3, para. 9).

In paragraph 20 of the Office Action, the Examiner correctly recites the requirement that “when evaluating the scope of a claim, every limitation must be considered.” (MPEP § 2106.II.C, citing *Diamond v. Diehr*, 450 U.S. 175, 188-89, 209 USPQ 1, 9 (1981)). However, the Examiner fails to follow the next mandate of § 2106.II.C, which requires that “USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation.” Applicants respectfully submit that both the current Office Action and the previous Office Action have done exactly that – dissected the limitations to allegedly find some teaching or suggestion in separate art references for each portion of the limitation, without showing a references that teaches or suggests the actual feature as claimed. However, by doing this, the Examiner is not properly construing the claims, reading portions of individual claim elements out of context and not giving them their full and accurate meaning.

Thus, by not reading the feature “determining a period of time, based upon the stored information and the post-issue event information, to complete a future payment to the payee issued on behalf of the payor” in its entirety, and by not considering the means by which a payment lead time is determined, as expressly recited by Claim 1, the Office Action is not properly construing this claim feature. Applicants are not attempting to patent any method or system for determining a payment lead time, but have instead provided claims directed to specific methods and systems – those that determine payment lead time for a given payee based on past payment information for that payee having the same form of payment, utilizing payment issue times and post-issue event information, as expressly recited by amended Claim 1, for example. Applicants respectfully submit that the Office Action still fails to show any teaching or suggestion in the cited art of the features *as claimed*, when reading every limitation and giving

the claims their full meaning without improperly dissecting the elements and considering them in isolation.

With respect to *Cataline*, Applicants respectfully submit that *Cataline* fails to teach, suggest, or render obvious the feature of “determining a payment lead time, based upon the stored information and the post-issue event information, to complete a future payment to the payee issued on behalf of a payor,” as recited in amended independent Claim 1. As stated above, the Office Action actually admits that the portion of “determining the period of time, based upon the stored information and the post-issue event information” is not taught by *Cataline*. Because this claim feature cannot be given its full meaning without attributing how the payment lead time is determined – “based upon stored information and the post-issue event information” – *Cataline* fails to teach or suggest this feature of independent Claim 1.

Notwithstanding, as stated in the remarks provided with the previous Amendment and Response filed on July 7, 2008 (which are hereby incorporated by references as if re-stated herein), nothing in *Cataline* teaches or suggests “determining a payment lead time . . . to complete a future payment to the payee,” as alleged in the Office Action. The portions of *Cataline* cited in the Office Action describe system features provided for processing a payment request after it has been received. For example, paragraph [0027] mentions that the system can “optimize the timing and technique used to effect various payments,” which is not related to determining a payment lead time. Paragraph [0051] describes scheduling payments for a payor, but in no way teaches or suggests determining or otherwise providing a payment lead time. Paragraph [0055] lists “lead time” as one of many variables that can be used to optimize the payment request received from the payor; however, the casual mention of the word “lead time” does not describe determining a payment lead time as recited in amended Claim 1. Finally, paragraph [0076] of *Cataline* poses the question “what is the timing necessary for the particular situation” as an inquiry regarding a timeframe or payment date indicated in the payment transaction itself, not a predetermined payment lead time based on historical payment information for the same payee.

In addition, independent Claim 1 has been further amended to include the feature “wherein each of the one or more payments have a same form of payment,” further clarifying that

each of the payments making up the payment history was made using the same form of payment. On the other hand, *Cataline* is only related to optimizing payment transactions by considering various options for processing that payment using information specific to each payment option. Accordingly, *Cataline* cannot be properly held to teach or suggest the feature of determining a payment lead time for a given payee, based on past payments of the same form to that payee.

With respect to *Rehkopf*, which the Office Action relies upon for showing the portion of the feature reciting “based upon the stored information and the received post-issue event information,” Applicants also submit that the Office Action improperly reads this feature out of context. The terms “stored information” and “post-issue event information” have particular meaning when the claim is read as a whole. Each of these terms are introduced and given meaning in earlier claim elements, which the Office Action ignores. “Stored information” has an antecedent association with the feature of “storing information identifying a payment issue time of each of one or more payments to a payee, wherein each of the one or more payments have the same form of payment.” “Post-issue event information” has an antecedent association with the feature of “post-issue information associated with each of the one or more payments.”

In contrast, *Rehkopf* is generally related to benchmarking, testing, and optimizing computer network processing. The specific examples relied upon by the Office Action are not even directed to a payment system, and the mere use of the term “bill computation system” is clearly inadequate to teach or suggest the specific features recited by amended Claim 1. Accordingly, notwithstanding the Office Action’s improper dissection of the claim features to show portions allegedly taught in the cited art, Applicants respectfully submit that *Rehkopf* does not teach or suggest the dissected portions of “stored information” or “post-issue event information” as expressly recited by amended independent Claim 1, let alone the entire feature if given its full meaning.

With reference to *Basch*, Applicants respectfully reassert the positions set forth in the previous Amendment and Response that *Basch* fails to teach or suggest “receiving post-issue event information” when giving the term “post-issue event information” its proper meaning, as explained above in light of *Rehkopf*. Nothing in *Basch* describes receiving post-issue event information that is associated with the same form of payment for a same payee or determining

payment lead times. Thus, *Basch* cannot be held to support a rejection of either of the features of “receiving post-issue event information . . .” or “determining a payment lead time . . .” using the post-issue event information. Thus, *Basch* fails to cure any of the other deficiencies of *Cataline* and *Rehkopf*.

Therefore, for at least these reasons, because *Cataline* does not itself teach or suggest “determining a payment lead time, based upon the stored information and the post-issue event information, to complete a future payment to the payee issued on behalf of a payor,” and because neither *Basch* nor *Rehkopf* cure the admitted deficiencies of *Cataline*, Applicants respectfully submit that independent Claim 1 is allowable over *Cataline*, *Basch*, and *Rehkopf*, and any combination thereof.

Amended independent Claims 16 and 44 each recite similar features as independent Claim 1, and therefore independent Claims 16 and 44 are allowable over *Cataline*, *Basch*, and *Rehkopf*, and any combination thereof, for at least the same reasons.

Furthermore, Applicants state that dependent Claims 2-4, 8-9, 13, 15, 17-19, 23-24, 28, and 30-43 are allowable as a matter of law as depending from an allowable claim, notwithstanding their independent recitation of patentable features.

Additional Reasons for Allowability of Select Dependent Claims

Notwithstanding that dependent Claims 2-4, 8-9, 13, 15, 17-19, 23-24, 28, and 30-43 are allowable as a matter of law, as provided above, Applicants provide additional reasons for allowability for example dependent claims.

With respect to dependent Claims 4 and 19, depending from independent Claim 1 and 16, respectively, Applicants submit that none of the cited references teach, suggest, or render obvious the features as recited therein. Specifically, with reference to dependent Claim 4 as an example, the type of “post-issue event information,” which is used when determining a payment lead time for a given payee, can be “posting information identifying the time the payee posts the payment . . . ,” “deposit information identifying the time that the payee deposits a payment instrument associated with the payment . . . ,” or “settlement information identifying a time that a financial institution . . . settles the debit” Accordingly, Claims 4 and 16 recite using at least one of

the posting, deposit, or settlement information and payment issue times associated with historical payments to identify a payment lead time for future payments to that payee.

As discussed above, and as admitted in the Office Action, (*see* Office Action, pg. 13-14), *Cataline* does not teach or suggest determining a payment lead time for a given payee based on past payment information associated with that payee. The mere reference of the term “lead time” in passing in *Cataline*, as described above, and does not provide an adequate teaching or suggestion of determining lead times in the manners expressly claimed. Therefore, *Cataline* necessarily does not teach or suggest determining payment lead times using either posting, deposit, or settlement information and payment issue times associated with historical payments to the payee, as recited in Claims 4 and 19.

While the Office Action relies on *Basch* in combination with *Cataline* for rejecting Claims 4 and 19, (*see* Office Action, pg. 14-15), the single statement that “historical clearing and settlement transactions” can be used to determine financial risk is insufficient to support a finding of obviousness of the features recited in amended Claims 4 and 19. *Basch* does not even teach or suggest determining payment lead times, but is instead associated with risk assessment. Thus, the combination of *Cataline* with *Basch* still does not provide any teaching or suggestion of the features recited in Claim 4 and 19.

Accordingly, Applicants respectfully submit that dependent Claims 4 and 19 are allowable over the cited art for at least these additional reasons.

With respect to Claims 9, 15, 24, 31, and 39, the Office Action alleges that the claims are directed to “further methods and systems that uses methods of algorithm to determine a period of time to complete a payment based on the sampling technique utilizing available historical transaction information.” The Office Action relies on *Basch* as disclosing “predictive modeling of financial transaction using different techniques,” referencing “decision tree, linear regression, logistical regression.” (Office Action , pg. 16). However, dependent Claims 9, 15, 24, 31, and 39 do not recite features similar to any of the predictive modeling techniques described by *Basch*. Each of these claims recite specific features that cannot be ignored or summarily dismissed when reviewing the cited art. Accordingly, Applicants respectfully submit that the Office Action fails

Application No.: 10/608,562

Filed: June 30, 2003

Amendment and Response to Office Action dated January 29, 2009

Page 25 of 26

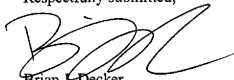
to sufficiently support its rejection of Claims 9, 15, 24, 31, and 39, and that these claims are allowable over the cited art.

CONCLUSION

Reconsideration of the Application is requested in light of the amended claims and the remarks. Applicants believe they have responded to each matter raised in the Office Action. Allowance of the claims is respectfully solicited. It is not believed that any extensions of time or additional fees are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 19-5029.

If there are any issues which can be resolved by teleconference call or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Brian J. Decker
Attorney for Applicants
Reg. No. 61,258

Date: April 29, 2009

SUTHERLAND ASBILL & BRENNAN LLP

999 Peachtree Street, NE

Atlanta, Georgia 30309-3996

Telephone: (404) 853-8130

Facsimile: (404) 853-8806

Attorney Docket No.: 23952-0142